



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 2876

In re

Patent Application of

Binh T. Lu et al.

Application No. 10/725,047

Confirmation No. 2957

Filed: December 1, 2003

Examiner: Caputo, Lisa M.

"POSTAL STAMP TRACKING SYSTEM AND
METHOD"

I, Molly Seymour, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.

Molly Seymour
Signature

May 18, 2005
Date of Signature

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants appeal from the final rejection dated October 19, 2004 and the Advisory Action dated March 17, 2005. Applicants note that a Notice of Appeal was filed March 18, 2005 and received by the Patent Office on March 21, 2005. Applicants enclose a check for \$500.00 in payment of the fee required under 37 CFR 41.20(b)(2). Please charge or credit deposit account No. 13-3080 with any underpayment or overpayment of fees.

(1) Real Party in Interest.

The real party in interest is Lockheed Martin Systems Integration, 6801 Rockledge Drive,
Bethesda, MD 20817.

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(2) Related Appeals and Interferences.

There are no related appeals or interferences.

(3) Status of Claims.

Claims 1, 3-7, 11-20, and 22-28 are pending and are included in Appendix A of this paper. Claims 1, 3-7, 11-20, and 22-28 stand rejected by the Examiner. Applicants appeal the rejection of claims 1, 3-7, 11-20, and 22-28. In addition, Applicants have included in Appendix B, the claims as they would appear had the amendment of February 14, 2005 been entered.

(4) Status of Amendments.

The amendment filed February 14, 2005 has not been entered. Amendments made to expedite resolution of a case made at any time after final rejection, but before jurisdiction has passed to the Board may be entered so long as the amendment conforms with the requirements of 37 C.F.R. 1.116. *See MPEP §1207*. Examples of amendments that will not be entered include amendments that necessitate a new search, raise the issue of new matter, present additional claims without canceling a corresponding number of finally rejected claims, or otherwise introduce new issues. *MPEP §1207*.

The Examiner argues that the claim amendments were not entered because “[t]he additional limitation of ‘without an onboard power supply’ (or ‘does not include an onboard power supply’) that was inserted into each of the independent claims (claims 1, 11, and 19) is a new issue that was not considered prior to the final rejection and hence requires further consideration and search.” *Advisory Action dated March 17, 2005, pg. 3*.

Applicants disagree with this conclusion. Prior to the amendment, claims 1, 11, and 19 included the limitation of a passive tracking device or a passive RFID device. RFID tags are generally classified into two broad groups, passive and active. *See Applicant's specification, pg. 3, line 10.* Applicants discuss the difference between passive and active RFIDs, stating “[p]assive tags do not include a power supply of their own, while active RFID tags include a power supply such as a battery.” *See Applicant's specification, pg. 3, lines 11-12.* Thus, Applicants' disclosure clearly would require that the Examiner's search include RFIDs that do not include a power supply. This search would necessarily encompass passive RFIDs that do not include an onboard power supply. Applicants contend that the amendment simply makes explicit that which is already part of the definition of the term “passive RFID.” Applicants believe the Examiner erred in not entering the amendments and asks that the amendments be entered and considered in this appeal.

(5) Summary of Claimed Subject Matter.

In one construction, illustrated in Fig. 1, the invention defines a trackable postage stamp that includes a first surface, and a second surface opposite the first surface and adapted to adhere to a piece of mail. *Specification, pg. 3, lines 2-5.* The postage stamp also includes a passive tracking device including a stamp identification number. *Specification, pg. 3, lines 2-9.* In one construction, the passive tracking device includes a radio frequency identification device (RFID). *Specification, pg. 3, lines 8-9.* Figs. 3, 4 and 7 illustrate another aspect of the invention. Figs. 3 and 4 illustrate a stamp dispensing system that is suited to dispensing stamps as illustrated in Fig. 1 and/or books of stamps as illustrated in Fig. 7. *Specification, pg. 8, lines 4-7.* The stamp dispensing system includes a stamp dispenser 40 that includes a plurality of postage stamps and

dispenses a product (stamp, book of stamps, roll of stamps, etc.) in response to a purchaser.

Specification, pg. 8, lines 9-17. As the product discharges from the machine, the product passes a reader that reads the passive RFID device. *Specification, pg. 8, lines 17-19.* In another aspect of the invention the stamp dispenser includes an imaging device that captures an image of the user of the dispenser. *Specification, pg. 10, lines 15-17.*

In yet another aspect, the invention discloses a method of tracking a postage stamp. The stamp is dispensed and data is read from the RFID tag. *Specification, pg. 8, lines 17-21.* The data can be stored within the vending machine or transmitted to a central database.

Specification, pg. 8, line 22 through pg. 9, line 2. As shown in Figs. 5-6, a mailbox also includes a reader. *Specification, pg. 9, lines 3-4.* The reader reads the tracking device as the mail is deposited. *Specification, pg. 9, lines 4-6.* The mailbox may include storage media for storing the read data or may include a wired or wireless transmitter for transmitting the read data to the central database. *Specification, pg. 9, lines 9-13.* In some constructions, an indicator is employed to notify postal workers that an envelope was sensed but the RFID tag was not read. *Specification, pg. 9, lines 20-22.*

The data within the database can be analyzed to look for patterns or individuals based on the stamps they use. *Specification, pg. 11, lines 14-15.* In one example, the system identifies stamps that are deposited into the postal system (e.g., via a mailbox) at a distance that is greater than a predefined distance from the location from which the stamp was purchased. *Specification, pg. 11, lines 15-17.*

(6) Grounds of Rejection to be Reviewed on Appeal.

Whether claims 1, 3-7, 11-20, and 22-28 are patentable under 35 U.S.C. §103(a) over various combinations of Tuttle (U.S. Patent No. 5,497,140), Conwell (U.S. Patent Application No. 2002/0135481), Porter (U.S. Patent No. 5,774,053), Barcelou (U.S. Patent No. 6,048,271), Levasseur (U.S. Patent No. 4,008,792), and Fite (U.S. Patent No. 6,467,684).

(7) Grouping of Claims.

The rejected claims do not stand or fall together, and the following groups are separately patentable:

- Group I: Claims 1, 3-7;
- Group II: Claims 11-17, 19, 22, and 26-28;
- Group III: Claim 18 and 20;
- Group IV: Claim 23;
- Group V: Claim 24; and
- Group VI: Claim 25.

(8) Argument.

To establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria. See *M.P.E.P.* § 706.02(j) and 2143.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, not in applicants' disclosure.

Id. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. *M.P.E.P.* § 706.02(j); *see also In re Rougget*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Appellant's disclosure. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988); *In re Vaeck*, 947 F.2d at 493, 20 U.S.P.Q.2d at 1442; MPEP §2143. The Examiner can only establish a *prima facie* case of obviousness by pointing out some objective teaching in the prior art references themselves that would lead one of ordinary skill in the art to combine the relevant teachings and the references. *In re Fine*, 837 F.2d at 1074, 5 U.S.P.Q.2d at 1598-99; *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); MPEP §2143.01. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

In addition, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); MPEP §2143.01.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *MPEP 2143.01*.

To properly establish a prima facie obviousness rejection under 35 U.S.C. §103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP §2142. Thus, hindsight based on the applicant's disclosure cannot be used to establish an obviousness rejection. *See id.*

Group I: Claims 1, 3-7

The claims of Group I, claims 1 and 3-7, are patentable separately from the other claims because these claims do not include all the limitations of the other claims and because these claims recite, inter alia, a stamp that includes a passive tracking device. More specifically, claims 1 and 3-7 are patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

Claim 1 defines a trackable postage stamp comprising a first surface and a second surface opposite the first surface and adapted to adhere to a piece of mail. The stamp also includes a

passive tracking device that including stamp identification (ID) information. If the February 14, 2005 amendment is entered, claim 1 will also include the limitations of claim 3, specifically that the passive tracking device includes a radio frequency identification device (RFID), and the phrase “without an onboard power supply.”

Tuttle discloses an electrically powered postage stamp or mailing label that includes a powered RFID device and system. The RFID system includes an IC chip, a RF antenna, and batteries, thus defining an active RFID system and not a passive system, much less a passive RFID system, as recited in amended claim 1.

Conwell does not cure the deficiencies of Tuttle. Conwell discloses a tamper-resistant label that includes a passive RFID transponder. The RFID transponder is sandwiched between a substrate and an adhesive with a tamper-resistant cover. Conwell does not teach or suggest applying passive RFID transponders, or any passive tracking device, to postage stamps or mailing labels. All Conwell teaches is that passive RFID transponders exist.

Active RFIDs and passive RFIDs are very different components. As stated in Applicants specification:

RFID tags are generally classified into two broad groups, passive and active. Passive tags do not include a power supply of their own, while active RFID tags include a power supply such as a battery. Active RFID tags are typically able to be read from greater distances when compared to passive RFID tags. In addition, active tags can typically store and transmit more information than can passive RFID tags. However, active RFID tags are typically larger and more expensive than passive RFID tags. In addition, active RFID tags have a limited life span due to their need for an internal power supply.

Specification, page 3, lines 10-17. As such, the applications that use one type of RFID will not necessarily work if the other type of RFID is employed. Thus, absent a specific teaching or suggestion, one of ordinary skill in the art would not assume that an application that employs an active RFID would also work using a passive tracking device such as a passive RFID.

Applicants find no suggestion or motivation, in either Tuttle or Conwell, that would lead one of ordinary skill in the art to combine the teachings of Tuttle and Conwell. Conwell teaches nothing regarding the use of passive tracking devices such as passive RFIDs in an item such as a postage stamp. The Examiner cites Conwell only for the teaching of a passive RFID on a label. Tuttle teaches the use of an active RFID and teaches away from the use of passive tracking devices such as passive RFIDs. Specifically, Tuttle states:

[The] prior art also includes smaller passive RFID packages which have been developed in the field of transportation and are operative for tracking automobiles. These reflective passive RFID packages operate by modulating the impedance of an antenna, but are generally inefficient in operation, require large amounts of power to operate, and have a limited data handling capability.

Tuttle Specification, col. 1, lines 61-67. The fact that Tuttle only discusses drawbacks of passive RFIDs would lead one of ordinary skill in the art to conclude that Tuttle believed passive tracking devices such as passive RFIDs were not suitable for a postage stamp or mailing label application.

In the Office action dated October 19, 2004, the Examiner argues that Tuttle discloses that passive RFIDs can be used to track small objects. The Examiner further argues, “in fact, Tuttle discloses alternatives to using a battery in the stamp embodiment (i.e., optical devices as recited in col. 7).” *Office action dated October 19, 2004, page 14.* Tuttle further states, “the present invention also includes forming an optical detector on the IC chip as a means of receiving and detecting signals carried by light and also as a means of powering the RFID transceiver as an alternative to using a battery.” *Tuttle Specification, col. 7, lines 27-31.* Furthermore, Tuttle discloses that RF charging may be employed in place of a battery. *See Tuttle Specification, col. 7, lines 8-9.* While Tuttle does disclose alternatives to batteries, Tuttle does not describe a passive tracking device or passive RFID as that term is defined in the specification

and as that term is known in the art. Tuttle's first alternative is to use an optical detector as a means of powering the RFID. This is akin to using a solar cell or solar power to power the RFID device. Thus, while it is not a battery, it is still an onboard power supply used exclusively by the particular RFID. Tuttle's second alternative relates to the use of RF charging. While Tuttle states that this eliminates a battery, it still requires an element to be charged, such as a capacitor. Thus, the RFID still includes an onboard power supply used exclusively by the RFID, and as such is an active RFID.

In light of the foregoing, Applicants argue that Tuttle only teaches the use of active RFIDs, as that term is defined in the specification and understood in the art. Tuttle teaches alternatives to a battery, however, each of these alternatives still provides an onboard power source for each RFID. Thus, the RFIDs of Tuttle are all active and there is no teaching or suggestion within Tuttle that would lead one to combine the teachings of Tuttle and Conwell. Thus, the Examiner has failed to show a teaching or suggestion, from within the references themselves and without the use of impermissible hindsight, that would lead one of ordinary skill in the art to combine Tuttle and Conwell. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Furthermore, even if one of ordinary skill in the art did combine the teachings of Tuttle with those of Conwell, there is no reasonable expectation of success. Tuttle discloses many of the disadvantages associated with using passive RFIDs in a mailing label or postage stamp application but never describes any solutions to these disadvantages. Conwell simply describes a passive system and makes no mention of its applicability to a postage stamp application. Thus,

one of ordinary skill in the art, upon reading Tuttle, would conclude that passive tracking devices such as RFIDs are not suitable for a postage stamp.

For these reasons, Applicants submit that Tuttle and Conwell alone or in combination do not teach or suggest the subject matter defined by claim 1. Accordingly, claim 1 is allowable. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 and allowance of claim 1. Claims 3-7 depend from claim 1 and are also allowable for these reasons.

The arguments presented above are equally applicable to the claims of Group I if the phrase "without an onboard power supply" is omitted from the claim as this phrase simply emphasizes the definition of passive devices such as passive RFID devices. As such, the entry or non-entry of the amendment filed February 14, 2005 will not affect the allowability of the Group I claims.

Group II: Claims 11-17, 19, 22, and 26-28

Claims 11-17, 19, 22, and 26-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al. (U.S. Patent No. 4,008,792), Fite et al. (U.S. Patent No. 6,467,684), and Conwell.

The claims of Group II, claims 11-17, 19, 22, and 26-28 are patentable separately from the other claims because these claims do not include all the limitations of the other claims and because these claims recite, inter alia, a reader operatively associated with a stamp dispenser to read stamp ID information from a passive RFID device attached to the stamp when the relative position between a stamp and the reader changes as the stamp is dispensed, and a database operable to store the read stamp ID information. More specifically, claims 11-17, 19, 22, and

26-28 are patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

The arguments presented above with regard to Group I apply with equal weight to Group II. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for the claims of Group I.

Claim 11 defines a postage stamp dispensing system that includes a plurality of postage stamps. Each stamp includes a tracking device that includes stamp ID information. A stamp dispenser is adapted to contain and dispense the stamps. A reader is operatively associated with the stamp dispenser to read the stamp ID information when the relative position between the stamp and the reader changes. A database is operable to store the read stamp ID information. Each tracking device includes a radio frequency identification (RFID) device. The RFID device is passive. If the February 14, 2005 amendment is entered, claim 11 will also include the limitation that the stamp ID information be read, "as the stamp is dispensed" and the phrase "that does not include an onboard power supply."

Claim 19 defines a method of tracking a postage stamp. The method includes coupling tracking information to the stamp, the tracking information including a stamp ID. The method also includes dispensing the stamp to a customer, reading the tracking information, and storing the stamp ID in a database. The tracking information is stored within a passive RFID device. If the February 14, 2005 amendment is entered, claim 19 will also include the step of reading the tracking information "as the stamp is dispensed." Claim 19 will also include the explicit recitation that the passive RFID does not include an onboard power supply.

In the Office action dated October 19, 2004 the Examiner argued that the combination of Tuttle and Conwell teaches the use of a passive RFID as a tracking device for a postage stamp.

As discussed with regard to the Group I claims, Tuttle and Conwell do not teach or suggest that a passive tracking device such as a passive RFID would be suitable as a tracking device for a postage stamp. As such, the Group II claims are allowable for the reasons set forth with regard to the Group I claims. In addition, the claims of Group II are separately patentable because these claims recite, inter alia, a reader that is operatively associated with the stamp dispenser to read the stamp ID information when the relative position between the stamp and the reader changes.

The Examiner cites Fite as teaching a reader that reads information when the relative position between a dispensed product and a reader changes. Fite discloses a system for selling and dispensing pre-paid cards for purchasing products or services. The cards include magnetic strips that can be read by card readers after the card is dispensed to the customer. However, Fite makes no mention of reading a passive RFID that is positioned on a stamp or other product, much less reading a passive RFID *as the stamp or product is dispensed* from a machine as is recited in the claims as amended in the Request for Reconsideration dated February 14, 2005. All Fite teaches is that a magnetic strip on a card can be read by a magnetic strip reader.

The Examiner cites Levasseur as teaching vend control circuits that allow the vending of various quantities of products at different prices. However, Levasseur teaches nothing regarding RFIDs, passive or active. Furthermore, Levasseur does not teach or suggest reading a passive RFID that is positioned on a stamp or other product, much less reading a passive RFID that is positioned on a stamp or other product *as the stamp or other product is dispensed* from the machine.

In addition, even if Tuttle, Fite, Levasseur, and Conwell teach the limitations of claims 11 and 19, a contention Applicants disagree with, the Examiner has failed to show any motivation, found within the references themselves, that would lead one of ordinary skill to combine these

four references. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).* The Examiner has clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required four references to do so.

Applicants have discussed the lack of a motivation to combine Tuttle and Conwell with regard to the claims of Group I and those arguments are equally applicable to the claims of Group II.

The Examiner combined the teachings of Levasseur with those of Tuttle and Conwell and stated that it would have been obvious to combine the teachings to arrive at a vending machine to dispense stamps because “this is an efficient and a convenient way for consumers to be able to purchase stamps when a conventional store is closed.” *Office action dated October 19, 2004, page 6.* The Examiner also states that Levasseur is properly combined with Tuttle and Conwell because Levasseur is from a related field, as “Levasseur teaches the dispensing/vending of stamps.” *Office action dated October 19, 2004, page 15.* Applicants disagree that Levasseur is from a related field and the Levasseur teaches the dispensing/vending of stamps. Levasseur teaches a vend control circuit and makes no mention of vending stamps. In addition, there is no suggestion in Tuttle, Conwell, or Levasseur that would lead one of ordinary skill in the art to combine these references. The fact that the claimed invention is more efficient and convenient for consumers does not make it obvious to combine references that are selectively culled to show the recited claim limitations.

In an effort to show all of the claimed limitations, the Examiner also combined the teachings of Fite with those of Tuttle, Levasseur, and Conwell. As discussed above, Fite does

not teach or suggest the limitations alleged by the Examiner. Furthermore, there is no suggestion in any of the references that would lead one of ordinary skill in the art to combine the teachings of Fite with those of Tuttle, Levasseur, and Conwell. The Examiner stated that it would have been obvious to combine the teachings because “it is favorable to be able to track an object that has been purchased by [sic] a consumer to ensure correct handling and operation.” *Office action dated October 19, 2004, page 8*. The Examiner further states that it would have been obvious to vend stamps and pre-paid cards in the same manner. *See Office action dated October 19, 2004, page 15*. Finally, the Examiner states that Fite is properly combinable with Tuttle, Levasseur, and Conwell as Fite teaches the intricacies of vending objects. *See Office action dated October 19, 2004, page 15*. However, Applicants see no teaching that would suggest stamps could be vended and tracked in a manner similar to that disclosed in Fite. If they were, each stamp would include a magnetic strip to allow for tracking. Thus, the Examiner relies on impermissible hindsight and the teachings of the Applicants to arrive at the incorrect conclusion that claims 11 and 19 are obvious. *See MPEP §2142 (discussing examiner’s requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art)*. The alleged fact that Fite teaches the intricacies of vending objects does not amount to a teaching of employing a reader to read information from stamps as they are vended.

For these reasons, it is submitted that Tuttle, Fite, Levasseur, and Conwell alone or in combination do not teach or suggest the subject matter defined by claims 11 and 19. Furthermore, even if Tuttle, Fite, Levasseur, and Conwell did teach all of the limitations of claims 11 and 19, a contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, and Conwell that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these four references to

arrive at the invention of claims 11 and 19 relies on impermissible hindsight after viewing the Applicants claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Accordingly, claims 11 and 19 are allowable. Claims 12-17 depend from allowable independent claim 11, and claims 22 and 26-28 depend from claim 19 and are allowable for the same and other reasons.

The arguments presented above are equally applicable to the claims of Group II if the phrase “without an onboard power supply” is omitted from the claim as this phrase simply emphasizes the definition of a passive RFID device. However, the addition of the phrase “as the stamp is dispensed” to claim 11 clarifies when the passive RFID must be read and further defines over the cited references. As the Examiner made no objection to this phrase in section 3 of the Advisory Action dated March 17, 2005 and Applicants have shown that the actual objection made was in error, Applicants respectfully request entry of the amendment and consideration of the amended claim 11.

Group III: Claims 18 and 20

Claims 18 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al. (U.S. Patent No. 4,008,792), Fite et al. (U.S. Patent No. 6,467,684), Conwell, and Barcelou (U.S. Patent No. 6,048,271).

The claims of Group III, claims 18 and 20, are patentable separately from the other claims because these claims do not include all the limitations of the other claims and because these claims recite, inter alia, an imaging device associated with the stamp dispenser and the step

of capturing an image of the customer. More specifically, claims 18 and 20 are patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

The arguments presented above with regard to Group I and Group II apply with equal weight to Group III. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for the claims of Group I and Group II.

Claim 18 depends from claim 11 and adds an imaging device operatively associated with the stamp dispenser to capture an image of the user of the stamp dispenser. Claim 20 depends from claim 19 and adds the step of capturing an image of the customer and storing the captured image in the database.

Barcelou does not teach or suggest each and every limitation of claims 11 or 19, much less those of claims 18 and 20. However, even if Barcelou did teach the limitations of claims 18 and 20, a contention Applicants disagree with, there is no suggestion in Barcelou, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. The Examiner is simply culling the claimed limitations from various references and using impermissible hindsight to find a justification for combining the teachings of Barcelou with those of Tuttle, Levasseur, Fite, and Conwell. Thus, the Examiner is relying on impermissible hindsight and the teachings of the Applicants' application to arrive at an improper obviousness rejection based on these five references. *See MPEP §2142 (discussing Examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 18 and 20 and allowance of claims 18 and 20.

Group IV: Claim 23

Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al., Fite et al., Conwell, and Porter (U.S. Patent No. 5,774,053).

The claim of Group IV, claim 23, is patentable separately from the other claims because the claim does not include all the limitations of the other claims and because the claim recites, inter alia, the step of reading tracking information from a stamp as the stamp is deposited in a mailbox. More specifically, claim 23 is patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

Claim 23 depends from claim 19 and adds the step of reading the tracking information as the stamp is deposited into a postal mailbox, and storing the stamp ID and a mailbox location within a database. The arguments presented above with regard to Group I and Group II apply with equal weight to Group IV. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for the claims of Group I and Group II. In addition to the arguments set forth above, claim 23 is allowable because Porter does not teach or suggest reading tracking information from a stamp as the stamp is deposited in a postal mailbox. Rather, Porter discloses a storage device that provides secure access to a space. A user places goods for delivery in the secured space after unlocking a lock actuator. To unlock the actuator, the user provides user information in the form of a key code, contactless smart card, or other device. Thus, Porter teaches a device that uses and stores user information to provide tracking and access control for a space. Porter does not teach or suggest reading a passive RFID that is attached to a stamp as the stamp is placed in the space. In fact, Porter does not teach or suggest reading any information associated with, or attached to the object being placed in the space.

Furthermore, even if Porter did teach the limitations of claim 23, a contention Applicants disagree with, there is no suggestion in Porter, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. The Examiner argues that it would have been obvious to combine Porter with Tuttle, Levasseur, Fite, and Conwell because Porter is from a related field “(i.e., . . . Porter teaches confirmation of a delivery of an object).” *Office action dated October 19, 2004, page 15*. However, Porter teaches nothing regarding a postal mailbox, a stamp, an RFID, or any other feature of the claimed invention and is not related in any way. Thus, Applicants are unable to find any suggestion in Porter, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine these five references. The Examiner is simply culling limitations from various references and using impermissible hindsight in an effort to justify combining their teachings. It is the invention of the trackable postage stamp that creates the ability to read tracking information from the stamp as the stamp is deposited in the mailbox. Without the Applicants’ invention, the ability and desire to read tracking information from a stamp would not exist. Thus, the Examiner is relying on impermissible hindsight and the teachings of the Applicants’ invention to arrive at an obviousness rejection based on these five references. *See MPEP §2142 (discussing examiner’s requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art)*. The Examiner has clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required five references to do so.

For these reasons, it is submitted that Tuttle, Levasseur, Fite, Conwell, and Porter, alone or in combination do not teach or suggest the subject matter defined by claim 23. Furthermore, even if Tuttle, Fite, Levasseur, Conwell, and Porter did teach all of the limitations of claim 23, a

contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, Conwell, or Porter that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these five references to arrive at the invention of claim 23 relies on impermissible hindsight after viewing the Applicants' claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Accordingly, claim 23 is allowable. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 23 and allowance of claim 23.

Group V: Claim 24

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al., Fite et al., Conwell, and Porter.

The claim of Group V, claim 24, is patentable separately from the other claims because the claim does not include all the limitations of the other claims and because the claim recites, inter alia, the steps of comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location. More specifically, claim 24 is patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

Claim 24 depends from claim 23 and adds the steps of comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location. The arguments presented above with regard

to Group I, Group II, and Group IV apply with equal weight to Group V. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for the claims of Group I, Group II, and Group IV. In addition to the arguments set forth above, claim 24 is allowable because Porter does not teach or suggest comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location. In fact, Porter makes no mention of comparing the location of the space with any location associated with the object disposed in the space. The Examiner also fails to find an explicit teaching within Porter, and instead states:

[i]n view of the teaching of Porter, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a system to be able to confirm the delivery of the articles with the trackable stamps to ensure that a correct delivery was made (this includes determining if the mailbox location is more than a predefined distance from the dispensing location).

Office action dated October 19, 2004, page 13. Applicants cannot find this teaching within Porter and conclude that even with the combination of five references, the Examiner is still unable to find a teaching of all of the limitations of claim 24.

Furthermore, even if Porter did teach the limitations of claim 24, a contention Applicants disagree with, there is no suggestion in Porter, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. For the reasons set forth with regard to the Group III claim, the teachings of Porter cannot be combined with those of Tuttle, Levasseur, Fite, and Conwell without the use of impermissible hindsight. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).* The Examiner has clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required five references to do so.

For these reasons, it is submitted that Tuttle, Levasseur, Fite, Conwell, and Porter, alone or in combination do not teach or suggest the subject matter defined by claim 24. Furthermore, even if Tuttle, Fite, Levasseur, Conwell, and Porter did teach all of the limitations of claim 24, a contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, Conwell, or Porter that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these five references to arrive at the invention of claim 24 relies on impermissible hindsight after viewing the Applicants' claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Accordingly, claim 24 is allowable. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 24 and allowance of claim 24.

Group VI: Claim 25

Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al., Fite et al., Conwell, and Porter.

The claim of Group VI, claim 25, is patentable separately from the other claims because the claim does not include all the limitations of the other claims and because the claim recites, inter alia, the steps of comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location. More specifically, claim 25 is patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

Claim 25 depends from claim 19 and adds the steps of sensing when an article is deposited in a mailbox, determining when tracking information was not properly read for all the articles placed in the mailbox, and providing a perceivable indication when it has been determined that tracking information was not properly read for all the articles placed in the mailbox. The arguments presented above with regard to Group I and Group II apply with equal weight to Group VI. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for the claims of Group I and Group II. In addition to the arguments set forth above, claim 25 is allowable because Porter does not teach or suggest reading any information from the object being placed in the space, much less identifying that information has not been properly read from one or more objects. Porter teaches a device that reads data associated with the user accessing the space. Porter does not teach reading information from an object that is being placed in the space.

Furthermore, even if Porter did teach the limitations of claim 25, a contention Applicants disagree with, there is no suggestion in Porter, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. For the reasons set forth with regard to the Group IV claim and the Group V claim, the teachings of Porter cannot be combined with those of Tuttle, Levasseur, Fite, and Conwell without the use of impermissible hindsight. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

For these reasons, it is submitted that Tuttle, Levasseur, Fite, Conwell, and Porter, alone or in combination do not teach or suggest the subject matter defined by claim 25. Furthermore, even if Tuttle, Fite, Levasseur, Conwell, and Porter did teach all of the limitations of claim 25, a

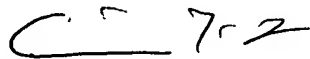
contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, Conwell, or Porter that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these five references to arrive at the invention of claim 25 relies on impermissible hindsight after viewing the Applicants claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).* The Examiner has clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required five references to do so.

Accordingly, claim 25 is allowable. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 25 and allowance of claim 25.

(9) Conclusion

In view of the foregoing, Applicants respectfully request entry of the amendment dated February 14, 2005 and allowance of claims 1, 4-7, 11-20, and 22-28. Alternatively, Applicants respectfully request reversal of the final rejection of claims 1, 3-7, 11-20, and 22-28 and allowance of claims 1, 3-7, 11-20, and 22-28.

Respectfully submitted,



Casimir F. Laska
Reg. No. 30,862

Docket No.: 061151-9010-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(262) 956-6523

APPENDIX A

Listing of Claims:

What is claimed is:

1. (Original) A trackable postage stamp comprising:
a first surface;
a second surface opposite the first surface and adapted to adhere to a piece of mail; and
a passive tracking device including stamp identification (ID) information.
2. (Cancelled)
3. (Original) The postage stamp of claim 1, wherein the passive tracking device includes a radio frequency identification (RFID) device.
4. (Original) The postage stamp of claim 1, wherein the stamp ID information includes encrypted data corresponding to at least two of a date, a location, a postage value, and a unique designation.
5. (Original) The postage stamp of claim 4, wherein encrypted data are combined to at least partially yield the stamp ID information.
6. (Original) The postage stamp of claim 1, wherein the passive tracking device is coupled to one of the first surface and the second surface.

7. (Original) The postage stamp of claim 1, wherein the stamp identification (ID) information is unique to each stamp.

8-10 (Cancelled)

11. (Previously Presented) A postage stamp dispensing system comprising:
a plurality of postage stamps, each stamp including a tracking device that includes stamp ID information;
a stamp dispenser adapted to contain and dispense the stamps;
a reader operatively associated with the stamp dispenser to read the stamp ID information when the relative position between the stamp and the reader changes; and
a database operable to store the read stamp ID information, wherein each tracking device includes a radio frequency identification (RFID) device, and wherein the RFID device is passive.

12. (Previously Presented) The system of claim 11, wherein the stamp ID information includes encrypted data corresponding to at least two of a date, a location, a postage value, and a unique designation.

13. (Original) The postage stamp of claim 12, wherein encrypted data are combined to at least partially yield the stamp ID information.

14. (Original) The system of claim 13, wherein the encrypted data that makes up the stamp ID information is stored as separate values in the database.

15. (Original) The system of claim 12, wherein the dispenser is a vending machine and the device reader is part of the vending machine.

16. (Original) The system of claim 12, wherein a portion of the plurality of stamps are arranged in a book and the book includes book identification data.

17. (Original) The system of claim 16, wherein the reader is operable to read the book identification data and the database is operable to store the book identification data.

18. (Previously Presented) The system of claim 11, further comprising an imaging device operatively associated with the stamp dispenser to capture an image of the user of the stamp dispenser.

19. (Previously Presented) A method of tracking a postage stamp, the method comprising:

- coupling tracking information to the stamp, the tracking information including a stamp ID;
- dispensing the stamp to a customer;
- reading the tracking information as the stamp is dispensed; and
- storing the stamp ID in a database,

wherein the tracking information is stored within a passive RFID device.

20. (Original) The method of claim 19, further comprising capturing an image of the customer and storing the captured image in the database.

21. (Cancelled)

22. (Original) The method of claim 19, further comprising storing a dispensing location within the database.

23. (Original) The method of claim 19, further comprising reading the tracking information as the stamp is deposited into a postal mailbox, and storing the stamp ID and a mailbox location within a database.

24. (Original) The method of claim 23, further comprising comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location.

25. (Original) The method of claim 19, further comprising
sensing when an article is deposited in a mailbox;
determining when tracking information was not properly read for all the articles placed in the mailbox; and
providing a perceivable indication when it has been determined that tracking information was not properly read for all the articles placed in the mailbox.

26. (Original) The method of claim 19, wherein the dispensing step includes dispensing the stamp as part of a book of stamps, and wherein the book includes book identification information.

27. (Original) The method of claim 26, wherein the reading step also includes reading the book identification information, and the storing step also includes storing the book ID in the database.

28. (Original) The method of claim 27, wherein the database includes a list of individual stamp IDs associated with the book ID.

APPENDIX B

Listing of Claims:

What is claimed is:

1. (Currently Amended) A trackable postage stamp comprising:
a first surface;
a second surface opposite the first surface and adapted to adhere to a piece of mail; and
a passive tracking device without an onboard power supply and including stamp identification (ID) information, wherein the passive tracking device includes a radio frequency identification device (RFID).
2. (Cancelled)
3. (Cancelled)
4. (Original) The postage stamp of claim 1, wherein the stamp ID information includes encrypted data corresponding to at least two of a date, a location, a postage value, and a unique designation.
5. (Original) The postage stamp of claim 4, wherein encrypted data are combined to at least partially yield the stamp ID information.

6. (Original) The postage stamp of claim 1, wherein the passive tracking device is coupled to one of the first surface and the second surface.

7. (Original) The postage stamp of claim 1, wherein the stamp identification (ID) information is unique to each stamp.

8-10. (Cancelled)

11. (Currently Amended) A postage stamp dispensing system comprising:

- a plurality of postage stamps, each stamp including a tracking device that includes stamp ID information;
- a stamp dispenser adapted to contain and dispense the stamps;
- a reader operatively associated with the stamp dispenser to read the stamp ID information when the relative position between the stamp and the reader changes as the stamp is dispensed; and
- a database operable to store the read stamp ID information, wherein each tracking device includes a radio frequency identification (RFID) device that does not include an onboard power supply, and wherein the RFID device is passive.

12. (Previously Presented) The system of claim 11, wherein the stamp ID information includes encrypted data corresponding to at least two of a date, a location, a postage value, and a unique designation.

13. (Original) The postage stamp of claim 12, wherein encrypted data are combined to at least partially yield the stamp ID information.

14. (Original) The system of claim 13, wherein the encrypted data that makes up the stamp ID information is stored as separate values in the database.

15. (Original) The system of claim 12, wherein the dispenser is a vending machine and the device reader is part of the vending machine.

16. (Original) The system of claim 12, wherein a portion of the plurality of stamps are arranged in a book and the book includes book identification data.

17. (Original) The system of claim 16, wherein the reader is operable to read the book identification data and the database is operable to store the book identification data.

18. (Previously Presented) The system of claim 11, further comprising an imaging device operatively associated with the stamp dispenser to capture an image of the user of the stamp dispenser.

19. (Currently Amended) A method of tracking a postage stamp, the method comprising:

- coupling tracking information to the stamp, the tracking information including a stamp ID;
- dispensing the stamp to a customer;
- reading the tracking information as the stamp is dispensed; and
- storing the stamp ID in a database,

wherein the tracking information is stored within a passive RFID device that does not include an onboard power supply.

20. (Original) The method of claim 19, further comprising capturing an image of the customer and storing the captured image in the database.

21. (Cancelled)

22. (Original) The method of claim 19, further comprising storing a dispensing location within the database.

23. (Original) The method of claim 19, further comprising reading the tracking information as the stamp is deposited into a postal mailbox, and storing the stamp ID and a mailbox location within a database.

24. (Original) The method of claim 23, further comprising comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location.

26. (Original) The method of claim 19, further comprising
sensing when an article is deposited in a mailbox;
determining when tracking information was not properly read for all the articles placed in the mailbox; and
providing a perceivable indication when it has been determined that tracking information was not properly read for all the articles placed in the mailbox.

26. (Original) The method of claim 19, wherein the dispensing step includes dispensing the stamp as part of a book of stamps, and wherein the book includes book identification information.

27. (Original) The method of claim 26, wherein the reading step also includes reading the book identification information, and the storing step also includes storing the book ID in the database.

28. (Original) The method of claim 27, wherein the database includes a list of individual stamp IDs associated with the book ID.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 2876

AF
JFW

In re

Patent Application of

Binh T. Lu, et al.

Application No. 10/725,047

Confirmation No.: 2957

Filed: December 1, 2003

Examiner: Caputo, Lisa M.

"POSTAL STAMP TRACKING SYSTEM AND
METHOD"

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Signature

May 18, 2005
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Respectfully submitted,

C. F. Laska
Casimir F. Laska
Reg. No. 30,862

File No. 061151-9010-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
262.956.6507



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Molly Seymour
Signature

May 18, 2005
Date of Signature

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Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
262.956.6507